

From: Fitzsimons, Michael

Sent: 7/29/2021 6:37:46 PM

To: TTAB EFiling

CC:

Subject: U.S. Trademark Application Serial No. 88190652 - SLEEPPEEZ - N/A - EXAMINER BRIEF

\*\*\*\*\*

Attachment Information:

Count: 1

Files: 88190652.doc

**United States Patent and Trademark Office (USPTO)**

**U.S. Application Serial No.** 88190652

**Mark:** SLEEPEEZ

**Correspondence Address:**

Erik M. Pelton

Erik M. Pelton & Associates, PLLC

PO Box 100637

Arlington VA 22210

**Applicant:** BFY LLC

**Reference/Docket No.** N/A

**Correspondence Email Address:**

uspto@tm4smallbiz.com

**EXAMINING ATTORNEY'S APPEAL BRIEF**

Applicant has appealed the trademark examining attorney's final refusal to register the mark SLEEPEEZ under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d), on the grounds that applicant's mark, when used on or in connection with applicant's goods, so resembles the mark in U.S. Registration No. 4123390 as to cause confusion, mistake, or deceive consumers as to the source of the goods of the applicant and registrant. *See* 15 U.S.C. §1052(d).

**I. FACTS**

On November 12, 2018, applicant, BFY LLC, a Connecticut limited liability company, filed an application to register the mark SLEEPEEZ, for, *“Homeopathic pharmaceuticals for use in the treatment of sleeping problems; Medicated candies”* in Class 5.

On December 10, 2018, the examining attorney<sup>1</sup> refused registration of the proposed mark under Trademark Act Section 2(d), on the grounds that applicant’s mark, when used on or in connection with applied-for goods, so resembled the mark in U.S. Registration No. 4123390 as to be likely to cause confusion as to the source of the respective goods. The cited registration is for the mark SLEEPEASE, for, *“Homeopathic preparations in the nature of an oral spray for the treatment of insomnia and symptoms of insomnia such as wakefulness, restlessness, caffeine sensitivity, emotional stress and anxiety.”* Additionally, applicant was required to amend the identification of goods to avoid a deceptiveness refusal, and was advised of a prior-filed application, which, if registered, could result in a refusal of applicant’s mark pursuant to Trademark Act Section 2(d) for a likelihood of confusion.

On June 10, 2019, applicant responded to the Office action and provided arguments against the Trademark Act Section 2(d) refusal, and amended the identification of goods to avoid a deceptiveness refusal.

On July 1, 2019, the examining attorney suspended action on the application pending the final disposition of the prior-filed application.

On September 10, 2020, action on the application resumed, the prior-filed application having abandoned. In the final Office action, the refusal pursuant to Trademark Act Section 2(d) was continued and made final.

---

<sup>1</sup> The application was reassigned to the undersigned examining attorney

On March 10, 2021, applicant filed an appeal with the Trademark Trial and Appeal Board (the “Board”), and a request for reconsideration of the refusal to register; on that same date the Board remanded the application to the examining attorney to consider applicant’s request for reconsideration.

On April 6, 2021, the examining attorney denied applicant’s request for reconsideration, maintaining the refusal to register pursuant to Trademark Act Section 2(d) because of a likelihood of confusion with the mark in U.S. Registration No. 4123390; the proceedings resumed the following day on April 7, 2021.

On June 4, 2021, applicant filed its appeal with the Board, which was forwarded to the examining attorney on June 9, 2021 for brief.

## **II. ISSUE**

The sole issue on appeal is whether there is a likelihood of confusion under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d), between applicant's mark, SLEEPEEZ, for use in connection with *“Homeopathic pharmaceuticals for use in the treatment of children's sleeping problems; Medicated candies for use in the treatment of children's sleeping problems”* in Class 5, and registrant’s mark, SLEEPEASE, for use in connection with *“Homeopathic preparations in the nature of an oral spray for the treatment of insomnia and symptoms of insomnia such as wakefulness, restlessness, caffeine sensitivity, emotional stress and anxiety”* in Class 5.

## **III. ARGUMENTS**

Trademark Act Section 2(d) bars registration of an applied-for mark that is so similar to a registered mark that it is likely consumers would be confused, mistaken, or deceived as to the commercial source of the goods and/or services of the parties. See 15 U.S.C. §1052(d). Likelihood of confusion is determined on a case-by-case basis by applying the factors set forth in *In re E. I. du Pont de Nemours &*

*Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973) (called the “*du Pont* factors”). *In re i.am.symbolic, llc*, 866 F.3d 1315, 1322, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017). Any evidence of record related to those factors need be considered; however, “not all of the *DuPont* factors are relevant or of similar weight in every case.” *In re Guild Mortg. Co.*, 912 F.3d 1376, 1379, 129 USPQ2d 1160, 1162 (Fed. Cir. 2019) (quoting *In re Dixie Rests., Inc.*, 105 F.3d 1405, 1406, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997)).

Although not all *du Pont* factors may be relevant, there are generally two key considerations in any likelihood of confusion analysis: (1) the similarities between the compared marks and (2) the relatedness of the compared goods and/or services. *See In re i.am.symbolic, llc*, 866 F.3d at 1322, 123 USPQ2d at 1747 (quoting *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1164-65, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 1103, 192 USPQ 24, 29 (C.C.P.A. 1976) (“The fundamental inquiry mandated by [Section] 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [or services] and differences in the marks.”); TMEP §1207.01.

### **1. The Marks are Confusingly Similar**

Marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1321, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014) (quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 1371, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005)); TMEP §1207.01(b)-(b)(v). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018) (citing *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)), *aff’d per curiam*, 777 F. App’x 516, 2019 BL 343921 (Fed. Cir. 2019); TMEP §1207.01(b).

Where the goods of an applicant and registrant are “similar in kind and/or closely related,” the degree of similarity between the marks required to support a finding of likelihood of confusion is not as

great as in the case of diverse goods and/or services. *In re J.M. Originals Inc.*, 6 USPQ2d 1393, 1394 (TTAB 1987); see *Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 1242, 73 USPQ2d 1350, 1354 (Fed. Cir. 2004); TMEP §1207.01(b). In the present case, the evidence of record establishes the close relationship between applicant's and registrant's goods, as discussed in further detail in the section below. Thus, the degree of similarity in the marks required to show a likelihood of confusion is lessened.

In the present case, applicant's and registrant's mark begin with the identical wording "SLEEP." Consumers are generally more inclined to focus on the first word, prefix, or syllable in any trademark or service mark. See *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1372, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005) (finding similarity between VEUVE ROYALE and two VEUVE CLICQUOT marks in part because "VEUVE . . . remains a 'prominent feature' as the first word in the mark and the first word to appear on the label"); *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 876, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992) (finding similarity between CENTURY 21 and CENTURY LIFE OF AMERICA in part because "consumers must first notice th[e] identical lead word"); see also *In re Detroit Athletic Co.*, 903 F.3d 1297, 1303, 128 USPQ2d 1047, 1049 (Fed. Cir. 2018) (finding "the identity of the marks' two initial words is particularly significant because consumers typically notice those words first").

The second part of applicant's mark, "EEZ" is highly similar in appearance and meaning to the second part of registrant's mark, "EASE," such that the marks create highly similar overall commercial impressions when used on similar goods. Marks may be confusingly similar in appearance where similar terms or phrases or similar parts of terms or phrases appear in the compared marks and create a similar overall commercial impression. See *Crocker Nat'l Bank v. Canadian Imperial Bank of Commerce*, 228 USPQ 689, 690-91 (TTAB 1986), *aff'd sub nom. Canadian Imperial Bank of Commerce v. Wells Fargo Bank, Nat'l Ass'n*, 811 F.2d 1490, 1495, 1 USPQ2d 1813, 1817 (Fed. Cir. 1987) (finding COMMCASH and COMMUNICASH confusingly similar); *In re Corning Glass Works*, 229 USPQ 65, 66 (TTAB 1985) (finding

CONFIRM and CONFIRMCELLS confusingly similar); *In re Pellerin Milnor Corp.*, 221 USPQ 558, 560 (TTAB 1983) (finding MILTRON and MILLTRONICS confusingly similar); TMEP §1207.01(b)(ii)-(iii). In the present case, applicant's and registrant's marks create similar overall commercial impressions because they begin with the identical wording "SLEEP," followed by the wording "EASE," or in applicant's case, the stylized misspelling of this term, i.e., "EEZ."

Indeed, the marks are essentially phonetic equivalents and thus sound similar. The record includes evidence from <https://www.merriamwebster.com/dictionary/ease>, <https://www.ahdictionary.com/word/search.html?q=ease>, <https://www.lexico.com/en/definition/ease>, <https://www.infoplease.com/dictionary/ease>, and <https://www.dictionary.com/browse/ease> showing that "EASE" in registrant's mark may be pronounced identically to "EEZ" in applicant's mark (December 10, 2018 Office action, TSDR pp. 6-18, and September 10, 2020 Office action TSDR pp. 8-15 ). Similarity in sound alone may be sufficient to support a finding that the compared marks are confusingly similar. *In re 1st USA Realty Profs, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007) (citing *Krim-Ko Corp. v. Coca-Cola Bottling Co.*, 390 F.2d 728, 732, 156 USPQ 523, 526 (C.C.P.A. 1968)); TMEP §1207.01(b)(iv).

The examining attorney notes that applicant has not argued that the marks are dissimilar, but has argued that the slight differences in the marks are sufficient to avoid confusion. This argument is addressed in further detail below.

Therefore, this factor favors a refusal.

## **2. The Goods are Encompassing and Closely Related**

The goods are compared to determine whether they are similar, commercially related, or travel in the same trade channels. *See Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369-71, 101 USPQ2d 1713, 1722-23 (Fed. Cir. 2012); *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1165, 64 USPQ2d 1375, 1381 (Fed. Cir. 2002); TMEP §§1207.01, 1207.01(a)(vi).

Determining likelihood of confusion is based on the description of the goods stated in the application and registration at issue, not on extrinsic evidence of actual use. *See In re Detroit Athletic Co.*, 903 F.3d 1297, 1307, 128 USPQ2d 1047, 1052 (Fed. Cir. 2018) (citing *In re i.am.symbolic, llc*, 866 F.3d 1315, 1325, 123 USPQ2d 1744, 1749 (Fed. Cir. 2017)).

In the present case, applicant's "*Homeopathic pharmaceuticals for use in the treatment of children's sleeping problems*" could encompass or be encompassed by registrant's "*Homeopathic preparations in the nature of an oral spray for the treatment of insomnia and symptoms of insomnia such as wakefulness, restlessness, caffeine sensitivity, emotional stress and anxiety,*" because applicant's goods are broadly worded enough to include homeopathic oral sprays for treatment of children's sleeping problems, and registrant's oral sprays for insomnia could include homeopathic pharmaceuticals for children's sleeping problems. *See, e.g., In re Solid State Design Inc.*, 125 USPQ2d 1409, 1412-15 (TTAB 2018); *Sw. Mgmt., Inc. v. Ocinomled, Ltd.*, 115 USPQ2d 1007, 1025 (TTAB 2015). Thus, applicant's and registrant's goods are legally identical in part. *See, e.g., In re i.am.symbolic, llc*, 127 USPQ2d 1627, 1629 (TTAB 2018) (citing *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp., Inc.*, 648 F.2d 1335, 1336, 209 USPQ 986, 988 (C.C.P.A. 1981); *Inter IKEA Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1745 (TTAB 2014); *Baseball Am. Inc. v. Powerplay Sports Ltd.*, 71 USPQ2d 1844, 1847 n.9 (TTAB 2004)).

In regards to applicant's "*Medicated candies for use in the treatment of children's sleeping problems,*" evidence of record in the form of excerpts of third-party websites from <https://www.puritan.com>, <https://www.nowfoods.com>, <https://www.tylenol.com>, <https://www.natrol.com>, <https://www.walmart.com>, <https://www.hylands.com>, <https://www.zarbees.com>, and <https://nestednaturals.com> show that manufacturers of medicated candies for treating children's sleep issues often make a variety of preparations for treating insomnia in various forms (December 10, 2018 Office action, TSDR pp. 24-39, and September 10, 2020 Office action TSDR pp. 16-74). Where evidence shows that the goods at issue have complementary uses, and thus are



often used together or otherwise purchased by the same purchasers for the same or related purposes, such goods have generally been found to be sufficiently related such that confusion would be likely if they are marketed under the same or similar marks. See *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 1567, 223 USPQ 1289, 1290 (Fed. Cir. 1984) (holding bread and cheese to be related because they are often used in combination and noting that “[s]uch complementary use has long been recognized as a relevant consideration in determining a likelihood of confusion”); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1272 (TTAB 2009) (holding medical MRI diagnostic apparatus and medical ultrasound devices to be related, based in part on the fact that such goods have complementary purposes because they may be used by the same medical personnel on the same patients to treat the same disease). In the present case, applicant’s medicated candies and registrant’s oral sprays are closely related and complementary in nature because they are both formulated for treatment of sleeping problems.

In addition to the third-party Internet evidence showing the closely related nature of the parties’ goods, the record includes evidence in the form of third-party registrations from the USPTO’s X-Search database consisting of a number of third-party marks registered for use in connection with the same or similar goods as those of both applicant and registrant in this case (December 10, 2018 Office action, TSDR pp. 40-77, and September 10, 2020 Office action TSDR pp. 75-122). This evidence shows that various types of pharmaceutical preparations for insomnia and sleeping problems, are of a kind that may emanate from a single source under a single mark. See *In re I-Coat Co.*, 126 USPQ2d 1730, 1737 (TTAB 2018) (citing *In re Infinity Broad. Corp.*, 60 USPQ2d 1214, 1217-18 (TTAB 2001); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988)); TMEP §1207.01(d)(iii).

The examining attorney notes that applicant has not argued that the goods are non-encompassing or unrelated for the purposes of determining a likelihood of confusion, but has argued that because of

alleged wide-spread use of similar marks for similar goods, that the slight differences in the goods are sufficient to avoid consumer confusion. This argument is addressed in further detail in the section below.

Therefore, this factor favors a refusal

### **3. Existence of a Limited Number of Third-Party Registrations and Evidence of Use of Similar Marks on Similar Goods Does Not Vitate a Likelihood of Confusion**

In its brief, applicant argues that because there are a number of other purportedly similar marks for sleep aid products being used in commerce and “*at least eight third-party registrations on the Principal Register that contain ‘SLEEP’ and ‘EASE’ for similar products, Registrant’s SLEEPEASE mark is entitled to a narrow scope of protection, such that differences in spelling and products will be enough to alleviate consumer confusion.*”

#### ***Third-Party Registration Evidence***

The examining attorney notes that active third-party registrations may be relevant to show that a mark or a portion of a mark is descriptive, suggestive, or so commonly used that the public will look to other elements to distinguish the source of the goods or services. *See, e.g., Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129 (Fed. Cir. 2015); *Juice Generation, Inc. v. GSEnters. LLC*, 794 F.3d 1334, 1338-40, 115 USPQ2d 1671, 1674-75 (Fed. Cir. 2015); *Primrose Ret. Cmty., LLC v. Edward Rose Senior Living, LLC*, 122 USPQ2d 1030, 1036 (TTAB 2016); *In re Hartz Hotel Servs., Inc.*, 102 USPQ2d 1150, 1153-54 (TTAB 2012); *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991); *In re Dayco Products-Eagle Motive Inc.*, 9 USPQ2d 1910, 1911-12 (TTAB 1988); *Plus Prods. v. Star-Kist Foods, Inc.*, 220 USPQ 541, 544 (TTAB 1983). Properly used in this limited manner, third-party registrations are similar to dictionaries showing how language is generally used. *See, e.g., Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 917, 189 USPQ 693, 694-95

(C.C.P.A. 1976); *In re J.M. Originals Inc.*, 6 USPQ2d 1393, 1394 (TTAB 1987); *United Foods Inc. v. J.R. Simplot Co.*, 4 USPQ2d 1172, 1174 (TTAB 1987).

Applicant made of record eight third-party registrations; however, only seven of the registrations are still active:

- Registration No. 4354543, EASY2SLEEP, for, “*Dietary supplement beverages for aiding sleep*”;
- Registration No. 4944530, GO SLEEP WITH EZZZ (with “SLEEP” disclaimed), for, “*Dietary and nutritional supplements*”;
- Registration No. 4779942, SLEEP EASY (with “SLEEP” disclaimed), for, “*Dietary supplements for aiding sleep*”;
- Registration No. 1921390, SLEEP EASE, for, “*non-medicated bath salts, bath gels and body lotions*” in Class 3, and “*medicated bath salts*” in Class 5;
- Registration No. 5237758, for, E-Z SLEEP SLEEP SHOT (with “SLEEP SHOTS” [sic] disclaimed), for, “*Nutritional supplements for use as a sleep aid*”;
- Registration No. 4854380, for SLEEP COMES EASY (with “SLEEP” disclaimed), for, “*Bath salts; Body lotions; Body sprays; Non-medicated balms for use on skin; Non-medicated body soaks*”;
- Registration No. 3827575, for, SLEEP-EZ AROMATHERAPY (with “AROMATHERAPY” disclaimed), for, “*Scented linen sprays; Scented room sprays.*”

Applicant argues that the third-party registrations it made of record “*are probative to demonstrate that all of the wording in the cited [r]egistration – “SLEEPEASE” – is commonly used in ordinary parlance to identify ingestible or inhalable sleep aids, making the term relatively weak.*” The examining attorney disagrees with applicant’s assertion, and submits that the third-party registration evidence is insufficient in quantity and in similarity to show that “SLEEPEASE” is conceptually weak.

Of the seven registrations, only four, Registration Nos. 4354543, 4944530, 4779942, and 5237758 identify goods similar to those of the applicant and the registrant in the present case. The goods identified in Registration Nos. 1921390, 4854380, and 3827575 include goods such as “*scented linen spays*,” “*bath salts*,” “*body lotions*,” and other cosmetic goods for which applicant has not established a close degree of similarity with the relevant goods of the applicant and registrant. Accordingly, the third-party registration evidence provided by applicant has little probative value in showing that “SLEEPEASE” is conceptually weak in the context of the relevant goods. *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 2745-46 (TTAB 2018) (discussing limited probative value of registrations of similar marks for related but not identical services), *aff’d mem.*, 777 F. App’x 516 (Fed. Cir. 2019).

In regards to the four third-party registrations covering goods that are similar in kind to the goods identified by the applicant and registrant in the present case, the marks do not contain the wording “SLEEPEASE,” and although similar to applicant’s and registrant’s marks, are readily distinguishable: EASY2SLEEP, GO SLEEP WITH EZZZ, SLEEP EASY, and E-Z SLEEP SLEEP SHOT. Even the most similar mark, Registration No. 4779942, for SLEEP EASY, covering “*Dietary supplements for aiding sleep*” is distinguishable from applicant’s and registrant’s marks because it is not phonetically identical to applicant’s and registrant’s marks and does not include the wording “EASE” or its phonetic equivalent.

The examining attorney submits that the existence of third-party registrations cannot justify the registration of another mark that is so similar to a previously registered mark as to create a likelihood of confusion, or to cause mistake, or to deceive. *E.g., In re i.am.symbolic, llc*, 866 F.3d 1315, 123 USPQ2d 1744 (Fed. Cir. 2017); *In re Max Capital Grp. Ltd.*, 93 USPQ2d 1243, 1248 (TTAB 2010); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1272 (TTAB 2009). In the present case, the third-party registrations submitted by applicant are insufficient in terms of quantity and quality in showing that registrant’s mark is conceptually weak for the relevant goods. Accordingly, the presence of these third-party registrations

cannot justify the registration of applicant's mark, which is phonetically identical to registrant's mark and identifies encompassing goods.

### ***Third-Party Use Evidence***

Evidence of third-party use falls under the sixth *du Pont* factor – the "number and nature of similar marks in use on similar goods." *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973). If the evidence establishes that the consuming public is exposed to third-party use of similar marks on similar goods, it "is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection." *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 1373-74, 73 USPQ2d 1689, 1693 (Fed. Cir. 2005); *see also In re FabFitFun, Inc.*, 127 USPQ2d 1670, 1675 (TTAB 2018) (finding the component term SMOKING HOT in the marks I'M SMOKING HOT and SMOKIN' HOT SHOW TIME to be "somewhat weak" based in part on evidence of third-party use of the term on similar cosmetics goods, noting that such uses "tend to show consumer exposure to third-party use of the term on similar goods"); *Mini Melts, Inc. v. Reckitt Benckiser LLC*, 118 USPQ2d 1464, 1470 (TTAB 2016) (noting that evidence that third parties had adopted marks that were the same as or similar to opposer's mark for use in connection with food products "may show that a term carries a highly suggestive connotation in the industry and, therefore, may be considered weak"); *but see Lilly Pulitzer, Inc. v. Lilli Ann Corp.*, 376 F.2d 324, 153 USPQ 406 (CCPA 1967) ("the existence of confusingly similar marks already on the register will not aid an applicant to register another confusingly similar mark").

In the present case, applicant argues that "*it is evident that consumers are exposed to a high number of 'SLEEP' plus 'EASE' marks for sleep aid goods and have learned to differentiate between them based on differences in spelling, goods, or other factors.*" To the degree that it is appropriate to consider

this evidence, the examining attorney submits that the third-party evidence is not sufficient to limit the scope of protection offered to registrant's mark.

In particular, applicant included evidence in the form of excerpts of third-party webpages showing use of the term "SLEEP EASE" or similar formatives thereof, used in connection with various goods. Some of the goods, such as dietary supplements, are similar to the goods of applicant and registrant in the present case. However, applicant has also included evidence for items such as massage candles, bath salts, herbal teas, inhalation beads, and other topical goods, which are not similar in kind to the goods of the applicant and registrant.

Specifically, of the approximately 26 examples of third-party use provided by applicant, nine of them are for unrelated goods and at least six of them are for marks that differ in sight, sound, and meaning from registrant's mark (e.g., "SLEEPEZ," "SLEEPEZ," "SLEEP EZE" and "SLEEP·EZE"), and are not examples of marks that combine "SLEEP" and "EASE" as asserted by the applicant. Further, at least one of the webpages, [https://www.olivetips.com/products/sleep-eze-extra-strength-20-gelcaps?gclid=Cj0KCQiA1pyCBhCtARIsAHaY\\_5cra1d1m2qRGUC2PmCUpsR-1TNm0bSLsUA0abPbrWkiSvM\\_xVb8PeAaAkYgEALw\\_wcB](https://www.olivetips.com/products/sleep-eze-extra-strength-20-gelcaps?gclid=Cj0KCQiA1pyCBhCtARIsAHaY_5cra1d1m2qRGUC2PmCUpsR-1TNm0bSLsUA0abPbrWkiSvM_xVb8PeAaAkYgEALw_wcB), is no longer accessible. Of the examples of third-party use of the terms "SLEEP" and "EASE" in connection with similar goods, the extent of consumer exposure to these usages is unclear, and in some cases, clearly diminutive. For example, a number of the websites provide opportunities for customer reviews, but no reviews or a very limited number of reviews are present, and in other cases, information on the websites suggest a limited geographic area where the goods are sold, e.g., <http://illuminutri.com/store/products/SleepEase.html> serving Southern Orange County, CA, and <https://economypharmacy.com/product/sleep-ease/> serving Tulsa and Muskogee, OK. While the goods may appear to be for sale over the internet, the duration, quantity, and geographic scope of such sales has not been established by the evidence of record. Indeed, a careful

review of the evidence shows that applicant has not established widespread or significant exposure of the combined terms “SLEEP” and “EASE” for similar goods.

Following the principle that “[t]he probative value of third party trademarks depends entirely upon their usage,” *Palm Bay Imports* 1772, 396 F.3d at 1373, the Board has routinely found that third-party evidence of real world use of trademarks is not sufficient to show that a registered mark is entitled to a limited scope of protection. *See, e.g., In re Fourth Wall Rests., LLC*, 2012 TTAB LEXIS 330 (TTAB Aug. 29, 2012) (finding that the 50 eating establishments shown in a Dun & Bradstreet® report using the mark HURRICANE were insufficient to find that the wording was crowded when comparing the marks THE HURRICANE CLUB and HURRICANE GRILL AND WINGS & Design); *In re Merrimack Acad. for the Performing Arts, Inc.*, 2010 TTAB LEXIS 192, \*13 (TTAB May 11, 2010) (noting that the third-party website evidence submitted had “limited probative value because there is no indication of the extent to which the services identified at the websites have been rendered, when the marks were adopted, or customer familiarity with the marks.”); *In re Madmann Trademark Holding Co.*, 2010 TTAB LEXIS 92 (TTAB Apr. 13, 2010) (finding that “a mere ten websites” and a Dun & Bradstreet® report identifying approximately fifty business in the food and restaurant field were insufficient to find that the term MAVERICK was entitled to only a limited scope of protection in the same); and *In re Slater*, 2006 TTAB LEXIS 91 (TTAB Mar. 13, 2006) (finding that over thirty examples of use of the mark LAKESHORE in third party websites and online directories, and results of Internet searches, were insufficient to find that the LAKESHORE mark was crowded in the real estate field). The Trademark Trial and Appeal Board has stated that decisions designated as not precedential are not binding upon the Board but may be cited for whatever persuasive value they might have. TBMP §101.03; TMEP §705.05.

In the present case, the evidence submitted by applicant does not include sufficient information to determine the extent of the exposure the relevant consuming public has to goods in which the “SLEEP

EASE” term is used. Accordingly, the evidence is insufficient to compel a finding that the mark in the cited registration is entitled to a narrow scope of protection.

Indeed, applicant’s relevant third-party registration and use evidence “is a far cry from the large quantum of evidence of third-party use and third-party registrations that was held to be significant in both” *Jack Wolfskin* and *Juice Generation. Inn at St. John’s*, 126 USPQ2d at 1746. Further, the cited registration issued without a requirement of showing acquired distinctiveness, so it is presumed to be inherently distinctive. *New Era Cap Co., v. Pro-Era LLC*, 2020 USPQ2d 10586, \*10 (TTAB 2020) (“Opposer’s mark is inherently distinctive as evidenced by its registration on the Principal Register without a showing of acquired distinctiveness under Section 2(f) of the Trademark Act.”); see also *Tea Bd. of India v. Republic of Tea*, 80 USPQ2d 1881, 1889 (TTAB 2006) (same).

To the extent that applicant’s evidence shows some conceptual weakness of registrant’s mark, even weak marks are entitled to protection against registration of nearly identical marks for encompassing and closely related goods. TMEP §1207.01(b)(ix); see *King Candy Co. v. Eunice King’s Kitchen, Inc.*, 496 F.2d 1400, 1401, 182 USPQ 108, 109 (C.C.P.A. 1974); *In re Max Capital Grp. Ltd.*, 93 USPQ2d 1243, 1246 (TTAB 2010).

The examining attorney further notes that a registration carries with it a presumption under Trademark Section 7(b) of the registrant’s ownership of the mark and the registrant’s exclusive right to use the mark in commerce on or in connection with the goods listed in the registration. 15 U.S.C. §1057. The third-party use evidence provided by applicant is not extensive enough in terms of the quantity of similar marks in use in connection with similar goods to overcome the protection afforded by registrant’s registration on the Principal Register, especially in this case, where the marks are nearly identical and the goods are encompassing and closely related. Therefore, the registration should be accorded the normal scope of protection to which an inherently distinctive mark is entitled. *Bell’s Brewery, Inc. v. Innovation*



*Brewing*, 125 USPQ2d 1340, 1348-49 (TTAB 2017). Accordingly, the sixth *DuPont* factor in this case is neutral.

### **CONCLUSION**

In conclusion, applicant's and registrant's marks are nearly identical, and the goods at issue are encompassing in part and otherwise closely related. Additionally, applicant's evidence under the sixth *DuPont* factor is insufficient to show that registrant's mark should be afforded a scope of protection so narrow that applicant's mark should be allowed to proceed to registration.

For the foregoing reasons, the trademark examining attorney respectfully requests affirmance of the refusal to register pursuant to Trademark Act Section 2(d).

Respectfully submitted,

/Michael FitzSimons/

Michael FitzSimons

Trademark Examining Attorney

Law Office 103

(571) 272-0619

michael.fitzsimons@uspto.gov

Stacy Wahlberg

Managing Attorney

Law Office 103

571-272-9441

[stacy.wahlberg@uspto.gov](mailto:stacy.wahlberg@uspto.gov)